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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,634	08/24/2001	Jeffrey Green	NAII P092/01.050.01	1385
28875	7590	08/19/2005	EXAMINER	
Zilka-Kotab, PC P.O. BOX 721120 SAN JOSE, CA 95172-1120			LIN, KELVIN Y	
			ART UNIT	PAPER NUMBER
			2142	
DATE MAILED: 08/19/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/935,634

Applicant(s)

GREEN ET AL.

Examiner

Kelvin Lin

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-30 and 32-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-30 and 32-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Detailed Action

Responds to Arguments

1. Claims 15, 17, and 34 are rejected under 35 USC 103 were not addressed by applicant.

Applicant should submit an argument under the heading "Remarks" pointing out disagreements with the examiner's contentions. Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them.

2. The Applicant's argument with respect to claims 1-14, 16, 18-33, and 35-40 have been considered but are not persuasive. Examiner appreciates detail description of prior art.

3. Regarding claim 1, in response to applicant's argument that Ji's disclosure does not meet "converting the certain electronic file to a second file format that is different from the first file format and that prevents the computer virus from executing when the converted electronic file is opened by the intended recipient".

Examiner respectfully disagrees.

4. First, Ji discloses the apparatus of performing virus detection on all messages received or transmitted from that node (Ji, col.6, l.64-67);

Secondly, Ji's disclosure clearly teaches that if a virus is detected, the present invention advantageously allows rename (converting) the file and store it in a specified directory and notify the user of the new file name and directory path which can be used according to user's needs and wants as specified in a configuration file (Ji, col.9, l.32-44). The renamed file corresponds to the "converting" the file to a second file format, because: first, Ji determines whether the file to be transferred is of a type that can contain viruses. This step is preferably performed by checking the extension of the file name. For example, .txt, .bmd, .pcx and .gif extension files indicate that the file is not likely to contain viruses while .exe, .zip, and .com extension files are of the type that often contain viruses (Ji, col.8, l.66-67, col.9, l.1-3). If the file to be transferred is not of a type that can contain viruses, then the method continues. Otherwise, if it is determined that the file to be transferred is of a type that can contain viruses the file is temporarily stored. Then the temporarily stored file is analyzed to determine if it contains viruses. However, if a virus is detected, the present invention advantageously allows rename the file and store it in a specified directory and notify the user of the new file name and directory path which can be used according to user's needs and wants as specified in a configuration file (Ji, col. 9, l. 1-44). Therefore, the renamed file type is "converted" to the format (e.g. .txt, .bmd, .pcx and .gif) that is not likely to contain viruses, and the format is different from the first format to prevent the virus infected file from being executed.

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5. Regarding claim 14, applicant argues that Ji's disclosure does not even suggest any sort of preventing virus execution in an electronic file ... and any mention of converting".

Similarly, Ji discloses if a virus is detected, the present invention advantageously allows rename the file and store it in a specified directory and notify the user of the new file name and directory path which can used according to user's needs and wants as specified in a configuration file (Ji, col. 9 , l. 1-44). Therefore, the renamed file type is "converted" to the format (e.g. .txt, .bmd, .pcx and .gif) that is not likely to contain viruses, and the format is different from the first format to prevent the virus infected file from being executed.

6. Regarding claims 16-18, applicant argued about type of files, i.e. the second file format being at least one of a TXT file format, which are mentioned in the Ji's disclosure (Ji, col.8, l. 67, col.9, l.1-2).

Similarly, claim 22 is rejected under the same reason as claims 16-18 listed above.

Response to Amended Claims

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-10, 12-14, 16, 18-30, 32-33, and 35-40 are rejected under 35 USC 102(b) as being anticipated by Ji et al., (U.S. Patent 5889943).

10. Regarding claim 1, Ji teaches a method carried out by a computer when executing computer-readable program code, the method comprising:

- receiving a certain electronic file intended for delivery from a sender to an intended recipient, the certain electronic file having a first file format having a first file extension and containing a computer virus (Ji, col.3, l.31-35, col.6, l.64-67);
and
- prior to the certain electronic file being made available for viewing by the intended recipient, converting the certain electronic file to a second file format having a second file extension that is different

from the first file extension of the first file format and that prevents the computer virus from executing when the converted electronic file is opened by the intended recipient (Ji, col. 8, l.59-67, col. 9, l.1-44, col. 18, l.1-4).

- wherein it is determined whether the certain electronic file represents a potential risk to security of a computer system (Ji, col. 18, l.45-47),
- said converting the certain electronic file being in response to a determination that the certain electronic file represents the potential risk to the security of the computer systems (Ji, col. 18, 47-51).

11. Regarding claim 2, Ji further discloses the method of claim 1, the certain electronic file being an attachment to an electronic mail sent over a network (Ji, col. 14, l.56-57).
12. Regarding claim 3, Ji further discloses the method of claim 2, the network including the internet (Ji, col.7, l.10-12).
13. Regarding claim 4, Ji further discloses the method of claim 1, said receiving occurring at a desktop computer of the intended recipient (Ji, col.13, l.25-40).
14. Regarding claim 5, Ji further discloses the method of claim 1, said receiving occurring at a server computer (Ji, col.3, l.31-34).
15. Regarding claim 6, Ji further discloses the method of claim 1, said

- receiving occurring at a gateway computer (Ji, col. 3, l.12-14) .
16. Regarding claim 7, Ji further discloses the method of claim 1, said converting occurring at a desktop computer of the intended recipient (Ji, col.12, l.22-25).
 17. Regarding claim 8, Ji further discloses the method of claim 1, said converting occurring at a server computer (Ji, col.6, l.61-63).
 18. Regarding claim 9, Ji further discloses the method of claim 1, said converting occurring at a gateway computer (Ji, col.3, l.12-14) .
 19. Regarding claim 10, Ji further discloses the method of claim 1, said converting occurring prior to the intended recipient receiving the certain electronic file (Ji, col. 4, l.10-16).
 20. Regarding claim 12, Ji further discloses the method of claim 1, said determining whether the certain electronic file represents the potential risk comprising: determining if the certain electronic file contains the computer virus (Ji, col. 18, l.45-47).
 21. Regarding claim 13, Ji further discloses the method of claim 1, said determining whether the certain electronic file represents the potential risk comprising: conducting a heuristic scan of the certain electronic file (Ji, col. 18, l.47-51).
 22. Regarding claim 14, Ji further discloses the method of claim, the certain electronic file being a first electronic file, further comprising:

- receiving a second electronic file intended for delivery from another sender to another intended recipient, the second electronic file having a third file format and containing another computer virus (Ji, col.13, l.22-23); and
- prior to the second electronic file being made available for viewing by the another intended recipient, converting the second electronic file to a fourth file format that is different from the third file format and that prevents the another computer virus from executing when the converted second electronic file is opened by the another intended recipient (Ji, col.14, l.32-38).

23. Regarding claim 16, Ji further discloses the method of claim 1, the second file format being at least one of a TXT file format, a RTF file format without embedded objects, a BMP file format, a JPEG file format, a CSV file format, a JPB file format, a GIF file format, a HTML file format without scripts, and a ASCII file format (Ji, col.8, l.67, col.11, l.59).
24. Regarding claim 18, Ji further discloses the method of claim 16, the second file format being the ASCII file format file (Ji, col.11, l.59).
25. Regarding claim 19, Ji further discloses the method of claim 16, the second file format being the TXT file format (Ji, col.8, l.67).
26. Regarding claim 20, Ji further discloses the method of claim 1, the second file format being a file format having text without scripts (Ji, col. 10, l.1-4).
27. Regarding claim 21, Ji further discloses the method of claim 1, the certain

electronic file being at least one of a word processing file, a spreadsheet file, a database file, a graphics file, a presentation file, a compressed file, and a binary executable file (Ji, col.14, l.32-37, col. 15, l.60-62).

28. Regarding claim 22, Ji further discloses the method of claim 1, further comprising:

- determining if the first file format is one of a word processing file format type and a graphics file format type (Ji, col.10, l.30-32),
- the second file format being at least one of a TXT file format, a RTF file format without embedded objects, and a HTML file format without scripts if it is determined that the certain file format is the word processing file format type (Ji, col. 6, l.52-53),
- the second file format being at least one of a JPB file format, a BMP file format, a GT file format, a HTML file format without scripts, and a TPEG file format if it is determined that the first file format is the graphics file format type (Ji, col. 10, l.30-33).

29. Regarding claim 23, Ji further discloses the method of claim 1, the certain electronic file being an electronic file received by at least one of a RTP transfer or a HTTP transfer protocol (Ji, col.15, l.9, Microsoft also supports RTP format).

30. Regarding claims 24-26 have similar limitation as claims 1,12, and 16.

Therefore, claims 24-26 are rejected under Ji for the same reason set forth in the rejection of claim 1, 12, and 16.

31. Regarding claim 27, Ji further discloses the method of 24, said

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- determining comprising: determining whether content of the electronic file reflects a potential computer virus (Ji, col. 18, 41-44).
32. Regarding claims 28-30, 32-33, and 35 have similar limitation as claims 1, 2, 10-12, 15-16, and 22. Therefore, claims 28-30, 32-33, and 35 are rejected under Ji for the same reason set forth in the rejection of claim 1, 2, 10-12, 15-16.
33. Regarding claims 36-37 have similar limitation as claims 1, and 7. Therefore, claims 36-37 are rejected under Ji for the same reason set forth in the rejection of claim 1, and 7.
34. Regarding claim 38, Ji further discloses the apparatus of claim 36, said computer being a server computer of a local area network (Ji, col. 21, l. 20).
35. Regarding claim 39, Ji further discloses the apparatus of claim 36, said Computer being a gateway computer (Ji, col. 21, l. 16-18).
36. Claim 40 is rejected based on the same reason as listed in Item 5, Response to Arguments.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

37. Claims 15, and 34 are rejected under 35 U.S.C 103(a) as being unpatentable over Ji in view of Chen (US Patent 5960170).

38. Regarding claims 15, and 34 Ji differs from the claimed invention in that it does not explicitly indicate the computer viruses (Ji, col.8, l.65, which means different kinds of virus) including macro virus.
- However, Chen teaches “the **macros viruses** used in the electronic mail ...” (Chen, col.14, l.54-57). With Chen’s elaboration and Ji’s description, therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Chen’s definition of macro virus with Ji’s e-mail attachment assertion and identified them more clearly.
39. Claim 17 is rejected under 35 U.S.C 103(a) as being unpatentable over Ji, in view of Chen as applied to claims 15, and 34 above, and further in view of Maloney et al., (US Patent 6549208).
40. Regarding claim 17, Ji as modified by Chen fails to teach the HTML file format without scripts.
- Maloney teaches the graphics extraction tool converts the reassembled HTTP flat files containing JPG and GIF data (Maloney, col.10, l.35-40).
- Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Ji and Maloney because they both deal with virus detection and analysis over the network.
- Furthermore, the teaching of Maloney’s hypertext conversion via electronic mail based on server security analysis over the network combine with Ji’s electronic mail virus detection and elimination system over the network delivery to the

recipient will increase efficiency for the polling and retrieval modules in the postal node for virus treatment. (Ji, Abstract).

Conclusion

41. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE MONTH shortened statutory period, then the shortened statutory period will expire on the date advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTH from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelvin Lin whose telephone number is 571-272-3898. The examiner can normally be reached on Flexible 4/9/5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number

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for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KYL
8/09/2005


KAMINI SHAH
PRIMARY EXAMINER